

REMARKS

Claims 1-9 and 12-16 are now present in this application.

The specification and claims 1 and 7-9 have been amended, claims 10 and 11 have been cancelled without prejudice or disclaimer of the subject matter contained therein, and claims 13-16 have been presented. Reconsideration of the application, as amended, is respectfully requested.

The Examiner has noted the two election requirements. It is noted that, from the second group, the claim 10 limitations have now been incorporated into independent claim 1. Claim 11 has therefore been cancelled. Applicants reserve the right to file a Divisional application directed to the non-elected type of intermediate layer.

Regarding the first election requirement of Group I, the species I as shown in Fig. 4 has been elected with traverse. It is respectfully submitted that independent claim 1 should be generic to all four disclosed species. This claim 1 should now be in condition for allowance. As such, it is requested that the election of species requirement be withdrawn and all claims considered.

Claims 1 and 10 stand objected to for a certain informality. Because this informality has now been addressed, it is respectfully requested that this objection now be reconsidered and withdrawn.

Claims 1, 4-7 and 10 stand rejected under 35 USC 103, as being unpatentable over SHIRA, U.S. Patent 5,669,825, in view of ISOBE et al., U.S. Patent 5,064,112. This rejection is respectfully traversed.

Claim 2 stands rejected under 35 USC 103 as being unpatentable over SHIRA in view of ISOBE et al., and further in view of TANAKA, U.S. Patent 5,769,307. This rejection is respectfully traversed.

Claim 12 stands rejected under 35 USC 103 as being unpatentable over SHIRA in view of ISOBE et al., and further in view of Japanese document 2003-25075. This rejection is respectfully traversed.

The patent to SHIRA discloses a method of making a golf club head and the article produced thereby. In this method, different portions of the head are fixed together. Independent claim 1 of the present application recites a first portion, a second portion, and an intermediate thin layer positioned between the abutting portion of the first portion and the abutting portion of the second portion. This intermediate layer and the abutting portion of the first portion are joined together by friction welding. Such friction welding is not carried out in the SHIRA device. If such joining were attempted, the golf club head would not be properly formed. Thus, the SHIRA device teaches away from such an arrangement.

In the present invention, the intermediate thin layer is capable of closely connecting between two abutting portions of the first and second portions after friction welding, and will thus improve the structural connection of the first portion with the second portion. The secondary reference to ISOBE et al. does not disclose a thin layer for connecting two members, but rather a thick layer. After friction welding, this thicker layer 2A, 2B must

be retained between two members of the machine part that may weaken the entire structure of the neck of the golf club head. Nonetheless, the ISOBE et al. patent is for machine parts such as hot wheels of turbo chargers, engine valves, turbine blades, and discs, as recited in the last paragraph of column 3. Thus, it is questioned whether one of ordinary skill in the golf club art would turn to the teachings of ISOBE et al. It is respectfully submitted that this is not analogous art. Even if, *in arguendo*, its teachings could be utilized to modify the device of SHIRA, a thin intermediate layer as claimed in the present application would not be obtained.

None of the prior art utilized by the Examiner would disclose an intermediate thin layer located between two abutting portions and friction welding. One of ordinary skill in the art could not possibly, in the absence of hind sight, have conceived of using the combination of the golf club head parts of SHIRA or TANAKA with a thicker intermediate portion of ISOBE et al. to achieve an intermediate thin layer of the claimed invention.

In addition, the dependent claims further define the present invention. For example, dependent claims 13 and 14 recite that the intermediate thin layer has a generally circular disc shape. Due to the convoluted cavity 12 used in SHIRA's device, such a generally circular disc shape intermediate layer could not be used.

Also, dependent claims 15 and 16 recite that the golf club shaft has a longitudinal axis which intersects the intermediate layer. Because the SHIRA patent is concerned with the head of a

gold club. the intermediate layer in this arrangement would not be intersected by the longitudinal axis of the shaft.

Nonetheless, independent claim 1 sets forth an arrangement which is neither suggested nor rendered obvious by the prior art utilized by the Examiner. Accordingly, it is respectfully requested that the 35 USC 103 rejections now be reconsidered and withdrawn.

Favorable reconsideration and an early Notice of Allowance are earnestly solicited.

In the event that any outstanding matters remain in this application, the Examiner is invited to contact the undersigned at (703) 205-8000 in the Washington, D.C. area.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

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